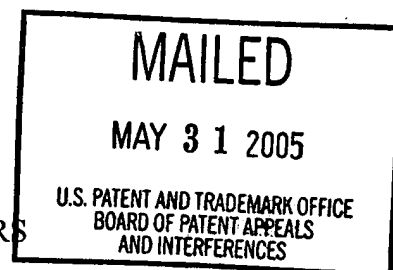


The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRIAN G. MORIN,
DANIEL T. MCBRIDE and LOREN W. CHAMBERS



Appeal No. 2005-0717
Application 09/178,396

HEARD: May 18, 2005

Before GARRIS, WARREN and JEFFREY T. SMITH, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 31, all of the claims in the application.

Claim 1 illustrates appellants' invention of a textile fabric coated with a particle attracting polymer that is useful to wipe, that is, clean, surfaces (specification, e.g., pages 1-3), and is representative of the claims on appeal:

1. An article comprising a textile fabric selected from the group consisting of woven, knitted, wet laid, dry laid and needle punched fabric, and a particle attracting polymer coated on the fabric, the article having a particle attraction coefficient of 50% or greater for one or more of the types of particles selected from the group consisting of carbon black, copper, copper oxide, silicon, silicon oxide, tungsten and tungsten oxide particles, and a particle release count of

particles greater than 0.5 microns of 75 million particles per square meter or less as measured by Biaxial Shake Test IEST-RP-CP-CC004.2.

The references relied on by the examiner are:

Zeidell	3,902,299	Sep. 2, 1975
Yahiaoui et al. (Yahiaoui)	5,814,567	Sep. 29, 1998

The examiner has rejected appealed claims 1 through 5, 7 through 11 and 13 through 30 under 35 U.S.C. § 103(a) as being unpatentable over Yahiaoui in view of Zeidell (answer, pages 3-5), and appealed claims 6, 12 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Yahiaoui in view of Zeidell and the admitted prior art at page 12, line 19, of the specification (answer, page 6).

Appellants group the claims of the first ground of rejection into two groups, citing certain claim limitations as the reason for each grouping, but do not further provide separate argument for either group or for any particular claim in a group (brief, pages 3-4 and 4-8). Appellants rely on “reasons stated above” in arguing the second ground of rejection (*id.*, pages 4 and 8-9).

We select one claim for consideration in each ground of rejection unless appellants provide reasons why an additional claim or additional claims in a ground of rejection is/are separately patentable. We point out that the controlling rule cautions that “[m]erely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.” Thus, we decide this appeal based on appealed claims 1 and 6 as representative of the grounds of rejection. 37 CFR § 1.192(c)(7) (2002); *see In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) (“*See* 37 CFR § 1.192(c)(7) (2001). If the brief fails to meet either requirement, the Board is free to select a single claim for each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of the rejection based solely on the selected representative claim.”); *see also* 37 CFR § 41.37(c)(1)(vii) (effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

We affirm.

Rather than reiterate the respective positions advanced by the examiner and appellants, we refer to the answer and to the brief for a complete exposition thereof.

Opinion

We have carefully reviewed the record on this appeal and based thereon find ourselves in agreement with the supported position advanced by the examiner that, *prima facie*, the claimed textile fabric coated with a particle attracting polymer encompassed by appealed claim 1 would have been obvious over the combined teachings of Yahiaoui and Zeidell¹ to one of ordinary skill in this art at the time the claimed invention was made. In view of the established *prima facie* case of obviousness, we again consider the record as a whole with respect to this ground of rejection in light of appellants' rebuttal arguments in the brief. *See generally, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

As an initial matter, we find that when the claim terms are given their broadest reasonable interpretation in light of the written description in the specification as interpreted by one of ordinary skill in the art, and without reading into the claims any limitation or particular embodiment disclosed in the specification, *see, e.g., In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), the plain language of claim 1 specifies an article comprising at least any manner of textile fabric prepared from any manner of material by one of the Markush group of methods and is further coated in any manner with any manner of at least one polymer that attracts one or more of the Markush group of particles, wherein the articles has (1) a particle attraction coefficient of 50% or greater for one or more of said Markush group of particles (see specification, e.g., pages 3-4), and a particle release count of particles greater than 0.5 microns of 75 million particles per square meter or less as measured by Biaxial Shake Test IEST-RP-CP-CC004.2 (see specification, e.g., page 14). *See generally, Exxon Chem. Pats., Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555, 35 USPQ2d 1801, 1802 (Fed. Cir. 1995) ("The claimed composition is defined as comprising - meaning containing at least - five specific ingredients."); *In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981) ("As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the term 'comprises'

¹ A discussion of Zeidell is not necessary to our decision. *See In re Kronig*, 539 F.2d 1300, 1302-04, 190 USPQ 425, 426-28 (CCPA 1976).

permits the *inclusion* of other steps, elements, or materials.”). The language specifying the textile fabric is couched in product-by-process format and the process limitations recited must be given weight as characterizing the claimed article. *See, e.g., In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 965-66 (Fed. Cir. 1985); *In re Bridgeford*, 357 F.2d 679, 682-83, 149 USPQ 55, 57-58 (CCPA 1966).

Appellants do not dispute that Yahiaoui discloses a textile fabric having a construction specified in claim 1. Indeed, the reference discloses, among others, woven fabrics of hydrophobic polymers (e.g., col. 3, l. 10, to col. 4, l. 6). Appellants further admit that Yahiaoui discloses “polymer coatings, such as those claimed by appellants” (brief, page 6), and we agree with the examiner that polysaccharide coatings disclosed by the reference (e.g., col. 7) are in common with the polysaccharide coatings encompassed in the claims (answer, e.g., page 3). As the examiner points out, Yahiaoui discloses that the coated polymer substrates thereof can be used as, among others, wipes (e.g., col. 2, l. 33).

On the basis of this substantial evidence we determine that one of ordinary skill in this art routinely following the teachings of Yahiaoui would have arrived at woven textile fabrics coated with a polysaccharide and useful as wipes that reasonably appear to be identical or substantially identical to the claimed woven textile fabrics that are coated with a polysaccharide and useful as wipes encompassed by claim 1, even though the reference is silent with respect to the particle attraction coefficient with respect to the claimed types of particles and to the particle release count as specified in claim 1. We note that the examiner finds that Yahiaoui uses the same coatings as appellants and thus would have the same inherent properties (answer, page 7).

Accordingly, the burden falls upon appellants to establish by effective argument or objective evidence that the claimed article patentably distinguishes over the articles disclosed by Yahiaoui, even though the rejection is based on § 103(a). *See, e.g., In re Best*, 562 F.2d 1252, 1255-56, 195 USPQ 430, 433-34 (CCPA 1977) (“Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. *See In re Ludtke*, [441 F.2d 660, 169 USPQ 563 (CCPA 1971)]. Whether the rejection is based on ‘inherency’

under 35 USC 102, on ‘prima facie obviousness’ under 35 USC 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products. [Footnote and citation omitted.]”); *In re Skoner*, 517 F.2d 947, 950, 186 USPQ 80, 82 (CCPA 1975) (“Appellants have chosen to describe their invention in terms of certain physical characteristics Merely choosing to describe their invention in this manner does not render patentable their method which is clearly obvious in view of [the reference]. [Citation omitted.]”); *cf. In re Spada*, 911 F.2d 705, 708-09, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990) (“The Board held that the compositions claimed by Spada ‘appear to be identical’ to those described by Smith. While Spada criticizes the usage of the word ‘appear,’ we think that it was reasonable for the PTO to infer that the polymerization by both Smith and Spada of identical monomers, employing the same or similar polymerization techniques, would produce polymers having the identical composition.”).

With respect to their burden, we find that appellants contend that the coated fabrics of Yahiaoui differ from the claimed coated fabrics because the reference does not disclose that the wipes thereof “have utility in cleanrooms” (brief, pages 5 and 6), pointing out that a “cleanroom wiper” cannot “release particulate matter” (brief, page 7). Appellants note the disclosure in Yahiaoui that in “wicking tests, the surface tension of an aqueous liquid is lowered, after contacting coated substrate” because “the coating is partially removed,” arguing that one of ordinary skill in the art “would avoid a coated substrate, such as disclosed by [Yahiaoui], because of the possibility that the coating would be a source of particulate contamination in cleanrooms” (brief, page 7; see also page 5, last two paragraphs). The difficulties that we have with appellants’ arguments are that there is no “cleanroom” use limitation in appealed claim 1, *see In re Self*, 671 F.2d 1344, 1348-49, 213 USPQ 1, 5 (CCPA 1982), and that appellants do not provide evidence establishing a relationship between the surface tension depression of an aqueous media as disclosed by Yahiaoui with respect to “durability” and the particle attraction coefficient and particle release count properties specified in claim 1. It is well settled that arguments not supported by evidence are entitled to little, if any, weight. *See In re Payne*, 606 F.2d 303, 315, 203 USPQ 245, 256 (CCPA 1979); *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972).

Appellants further rely on the “unexpected advantage” that the claimed article “demonstrates an improvement in adsorption of typical particulate contaminants of 50% or greater, or even 100% or greater, relative to an uncoated cleanroom wiper.” We find no evidence referred to in the brief with respect to this alleged comparison, *see Payne*, 606 F.2d at 315, 203 USPQ at 256; *Lindner*, 457 F.2d at 508, 173 USPQ at 358, and we will neither look for any supporting evidence in the record before us nor attempt to independently determine the significance of any evidence we become aware of with respect to the issue here. *Cf. In re Baxter Travenol Labs.*, 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) (“It is not the function of this court to examine the claims in greater detail than argued by appellant, looking for nonobvious distinctions over the prior art.”). Indeed, assuming *arguendo* that there is evidence in the record, the comparison with “an uncoated cleanroom wiper” would not establish any difference between the apparently chemically identical or substantially identical claimed coated fabrics encompassed by claim 1 and the coated fabrics of Yahiaoui. *See Best*, 562 F.2d at 1256, 195 USPQ at 434; *cf. Spada*, 911 F.2d at 709, 15 USPQ2d at 1658; *In re Hoch*, 428 F.2d 1341, 1343-44, 166 USPQ 406, 409 (CCPA 1970) (evidence must provide an actual comparison of the properties of the claimed compositions with compositions of the reference).

Appellants also contend that “[w]ithout question, there has been a long-felt need for a cleanroom wiper, which not only has a very low particle release count, but improved contaminate pick-up,” citing several references in support of their position (brief, pages 7-8).

The burden of establishing a nexus between the claimed features of the invention and the objective evidence with respect to long-felt need rests with appellants. *See Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1017, 226 USPQ 881, 888 (Fed. Cir. 1985). The weight to be accorded to the objective evidence depends upon the extent to which appellants demonstrate the required nexus. *See In re GPAC, Inc.*, 57 F.3d 1573, 1580, 35 USPQ2d 1116, 1121-22 (Fed. Cir. 1995). “Whether the evidence presented suffices to rebut the prima facie case is part of the ultimate conclusion of obviousness and is therefore a question of law.” *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). “The relevant secondary consideration is ‘long-felt but unsolved need,’ not long-felt need in isolation.” *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 884, 45 USPQ2d 1977, 1983 (Fed. Cir. 1998). A

long-felt need can be established by showing that a long standing industry-wide need was solved by the claimed invention. *See, e.g., Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1325, 50 USPQ2d 1161, 1171-72 (Fed. Cir. 1999); *cf. e.g., See B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996). However, “once another supplies the key element, there was no longer long-felt need or, indeed, a problem to be solved.” *Newell Cos., Inc. v. Kenney Mfg. Co.*, 864 F.2d 757, 768, 9 USPQ2d 1417, 1426 (Fed. Cir. 1988). In any event, evidence of nonobviousness based on secondary considerations, although being factors that certainly must be considered, are not necessarily controlling when weighed with evidence of obviousness. *See e.g., B.F. Goodrich*, 72 F.3d at 1583, 37 USPQ2d at 1318-19 (“Considering the minor difference between the claimed invention and the teachings of Dunlop, the secondary considerations were not sufficiently compelling. [Citation omitted.]”); *Newell Cos., supra*.

We fail to find in appellants’ brief any evidence or reference to evidence in the record which establishes that there was a long-felt need in the art for different coated fabric for use as wipes, that this need was solved by the claimed coated fabrics encompassed by claim 1 which are identical or substantially identical to the coated fabrics of Yahiaoui relied on, and that such claimed coated fabrics are different from the coated fabrics of Yahiaoui and thus the latter does not supply the key element, that is, the coating, that solves the long-felt need. By appellants’ own analysis, the content of the two articles on which they rely (brief, pages 7-8) does not even relate to the claimed coated fabrics. As we pointed out above, we will neither peruse the record for additional evidence with respect to this issue nor divine appellants’ arguments based thereon if we become aware of pertinent evidence.

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in the combined teachings of Yahiaoui and Zeidell with appellants’ countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 1 through 5, 7 through 11 and 13 through 30 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

Turning now to the rejection based on the combined teachings of Yahiaoui, Zeidell and the admitted prior art in the specification, we pointed out that appellants rely on arguments that

we have considered with respect to the first ground of rejection (*see above* p. 2). Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in the combined teachings of Yahiaoui, Zeidell and the admitted prior art in the specification with appellants' countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 6, 12 and 31 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

The examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

AFFIRMED

Buddley R. Z. Carri

BRADLEY R. GARRIS
Administrative Patent Judge

Robert F. Turner

CHARLES F. WARREN
Administrative Patent Judge

Jeffrey J. Smith

JEFFREY T. SMITH
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

Appeal No. 2005-0717
Application 09/178,396

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